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09/585,460	06/01/2000	Jonathan Strietzel	252/173	3051

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EXAMINER	
NGUYEN, QUYNH H	

ART UNIT	PAPER NUMBER
2614	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/585,460	STRIETZEL, JONATHAN	
	Examiner	Art Unit	
	Quynh H. Nguyen	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *amendment filed 12/5/07*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13,33,35,36,38-50,59-66 and 76-84* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13,33,35,36,38-50,59-66 and 76-84* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

2. Applicant's amendment filed on 12/05/07 has been entered. No claims have been amended. Claims 37 and 58 have been cancelled. No claims have been added. Claims 13, 33, 35-36, 38-50, 59-66, and 76-84 are still pending in this application, with claims 13, 76, and 83 being independent.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 84 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification. Claim 84 recites the limitation "...less than 1 second long" that was not described in the specification. In Applicant's own specification, page 8, stated that "Typically, the ringback signal consists of short rings every few seconds. In this implementation, therefore, a short advertisement is played in place of the rings", and there is no where in the specification that define "the at least one advertisement associated with the source is less that 1 second long". For the purpose of examination,

Examiner interprets claim 84 as "The telecommunications advertising system of claim 13, where the at least one short advertisement associated with the source is played in place of the rings".

Claim Rejections - 35 USC § 103

5. Claims 13, 33, 35-36, 38-48, 59-64, and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (U.S. Patent 5,557,658) in view of Hidary (US Patent 5,852,775) and further in view of Inoue et al. (JP 57087661).

Regarding claim 13, Gregorek teaches an advertisement database (Fig. 4, 60) that stores subscriber specific ("customized menu"); and a processing mean ("message generator") configured to selectively associate, based on one or more factors selected from the group consisting of user preferences ("customized menu selection"), time of day (col. 9, lines 5-10), communication source ("the network address of the first telephone 12 or other device") and geography (col. 9, lines 17-28 and col. 19, lines 53-60), communication types (col. 6, lines 22-26), communication destination ("services provided by a particular corporation or individual" - col. 14, lines 53-54), at least one advertisement in the advertisement database with a source of the incoming communication and with a destination of the incoming communication (col. 19, lines 53-60). Gregorek further teaches the message generator determines the duration in which the announcements are to be played (col. 11, lines 29-31), and the message sequence may be interrupted at any point subsequent to the switch determining that the destination phone is idle (col. 12, lines 47-50) reads on the ringback signal continue to

be applied to the source until after the advertisement applied to the destination is complete.

Gregorek does not specifically teach the advertisement associated with the destination to be routed to the destination when the destination goes off hook in response to the incoming communication, and routing the associated advertisement to the destination of an incoming communication; and causing the at least one advertisement associated with the source to replace the rings of a ringback signal that would normally be routed to the source.

Hidary teaches the advertisement associated with the destination to be routed to the destination when the destination goes off hook in response to the incoming communication (col. 4, lines 13-25 - *where Hidary discussed the manner of establishing communication between subscribers 16 and 16A when subscriber 16 initiates a call to a subscriber 16A is well known, subscriber 16A receives advertisement selected from memory based on the profile of subscriber 16A, hence in an ordinary manner, when the destination (subscriber 16A) goes off hook in response to the incoming communication from subscriber 16, the advertisement associated with the destination routed to the destination*). Hidary further teaches routing the associated advertisement to the destination of an incoming communication (col. 4, lines 13-25). Please note that in Hidary's system, the MTSO provides communication for standard cellular telephone service and standard hard wired telephone system (col. 1, lines 49-50; col. 1, line 66 through col. 2, line 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hidary into the teachings of Gregorek for the purpose of being able to productively occupy the time when both the calling and called parties are on the line, and to avoid both parties to listen to a meaningless or annoying busy signal, a ringback signal, or wait idly while one of the parties station receives another call or processes information; and providing users with useful information, as discussed by Gregorek (col. 2, lines 11-16). However, Gregorek and Hidary do not explicitly teach playing advertisement associated with the source to replace the rings of a ringback signal that would normally be routed to the source.

Inoue et al. teaches the TKE signal replace the entire signal / tone which including rings of a ringback signal portions that would normally be routed to the source (abstract; Fig. 3b; pages 4-5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Inoue into the teachings of Gregorek and Hidary for the purpose of having a more efficient system and utilizing the time during which the call is being set up or when a busy called terminal is discovered, and playing short advertisement alternatively to replace the rings of a ringback signal in order for the caller to listen to various information / advertisements for a short time of waiting until the called party responds.

Regarding claims 33 and 35-36 Gregorek teaches the processing means is configured to cause the advertisement associated with the source to replace a dial tone that would normally be routed to the source, to be routed to the source prior to

connecting the source with the destination, and just prior to a dial tone being routed to the source (col. 2, lines 11-30 and lines 63-67; col. 8, line 61 through col. 9, line 4; col. 16, lines 17-21 and lines 38-43).

Regarding claim 38, Hidary teaches the advertisement associated with the source to be routed to the source (col. 1, lines 57-65; col. 3, lines 30-54) when the advertisement associated with the destination is routed to the destination (col. 4, lines 13-25).

Regarding claim 39, Gregorek teaches the message generator determines the duration in which the announcements are to be played (col. 11, lines 29-31). However, Gregorek does not teach the advertisement associated with the source and the advertisement associated with the destination last the same amount of time. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature mentioned above to Gregorek's system in order to stop the advertisements at the source and the destination at the same time when call processing is established.

Regarding claims 40 and 41, Gregorek teaches (Fig. 1) a switching center (Fig. 1,15, 21) interfaced with the source and the processing means comprises part of the switching center and a router to route the incoming call from the source (Fig. 1,12) to the destinations (Fig. 1, 20, 28).

Regarding claims 42, 43, and 59, Gregorek teaches the database (Fig. 2, 102) configured to store the user preferences (col. 9, lines 55-61).

Regarding claims 44-48, and 60-64, Gregorek teaches the users preferences can be of any particular subject matter (col. 14, lines 50-57). Hidary teaches the user preferences include the user's age, salary, marital status, number of children, and user's buying preferences, etc. (col. 1, lines 61-64).

Regarding claim 84, Inoue et al. teaches the TKE signal replace the entire signal / tone which including rings of a ringback signal portions that would normally be routed to the source (abstract; Fig. 3b; pages 4-5).

6. Claims 49-50 and 65-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. in view of Hidary and Inoue and further in view of Creamer et al. (US Patent 6,028,917).

Regarding claims 49-50 and 65-66, Gregorek, Hidary, and Inoue do not specifically teaches the user can access the database that is interfaced with the Internet to update their user preferences via the Internet.

Creamer et al. teaches the user can access the database that is interfaced with the Internet to update their user preferences via the Internet (abstract; col. 2, lines 15-30, 32-42, and line 65 through col. 3, line 9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Creamer in to the teachings of Gregorek, Hidary, and Inoue for the purpose of allowing users to activate/modify their user preferences via web browser for speedy service rather than placing a request then waiting for an operator from central office to perform the modifications that would take

up to few days.

7. Claim 76 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chavez, Jr. et al. (US Patent 6,603,844) in view of Inoue et al. (JP 57087661).

Regarding claim 76, Chavez et al. teach a telecommunications advertising system comprising: an advertisement database that stores subscriber specific or third party advertisements (col. 2, line 63 through col. 3, line 1; col. 3, lines 25-29 - *where Chavez discussed the control processor 102 accesses an internal table to determine what advertisement should be transmitted to the caller*); and a processing means (*control processor 102*) configured to selectively associate a plurality of advertisements in the advertisement database with a source of the incoming communication (col. 3, lines 25-29) and to cause the plurality of advertisement associated with the source to replace the ringback signal that would normally be routed to the source (abstract; col. 1, lines 57-62; col. 3, lines 16-29).

Chavez et al. does not explicitly teach short advertisements replace the rings of a ringback signal.

Inoue et al. teaches the TKE signal replace the entire signal / tone which including rings of a ringback signal portions that would normally be routed to the source (abstract; Fig. 3b; pages 4-5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Inoue into the teachings of Chavez for the purpose of playing short advertisement alternatively to replace the rings of a

ringback signal in order for the caller to listen to various information / advertisements for a short time of waiting until the called party responds.

8. Claims 77 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chavez, Jr. et al. (US Patent 6,603,844) in view of Inoue et al. (JP 57087661) and further in view of Gregorek et al. (U.S. Patent 5,557,658).

Regarding claim 77, Chavez et al. teach configured to selectively associate a plurality of short advertisements in the advertisement database with a source of the incoming communication (col. 3, lines 25-29).

Chavez and Inoue do not teach based on one or more factors selected from the group consisting of user preferences, time of day, communication source and geography, communication types, communication destination.

Gregorek teaches based on one or more factors selected from the group consisting of user preferences ("customized menu selection"), time of day (col. 9, lines 5-10), communication source ("the network address of the first telephone 12 or other device") and geography (col. 9, lines 17-28 and col. 19, lines 53-60), communication types (col. 6, lines 22-26), communication destination ("services provided by a particular corporation or individual" - col. 14, lines 53-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Gregorek into the teachings of Chavez and Inoue for the purpose of playing preferred advertisements to the users.

Claim 83 is rejected for the same reasons as discussed above with respect to claims 76 and 77.

9. Claims 78-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chavez, Jr. et al. (US Patent 6,603,844) in view of Inoue et al. (JP 57087661) and further in view of Hidary (US Patent 5,852,775).

Regarding claims 78-82, Chavez and Inoue do not explicitly teaches the user preferences include the user's age, salary, marital status, number of children, and user's buying preferences.

Hidary teaches the user preferences include the user's age, salary, marital status, number of children, and user's buying preferences, etc. (col. 1, lines 61-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hidary into the teachings of Chavez and Inoue for the purpose of selecting and playing preferred / appropriate advertisements to the right users.

Response to Arguments

10. Applicant's arguments filed 12/5/07 have been fully considered but they are not persuasive. Applicant's arguments are addressed in the above claims rejections.

Regarding claims 84 is rejected under 35 USC 112, first paragraph, Applicant argues that "the specification as filed inherently teaches that an advertisement replacing a ring tone in a ring back signal can be less than 1 second long". Examiner disagrees

and maintains the rejection, because there is no where in the specification that define "the at least one advertisement associated with the source is less that 1 second long".

Applicant mainly argues that in Inoue, a TKE is replace over the entire ring back signal, and a second in which the period between the ring tones is replaced with TKE signal. Examiner agrees with Applicant that in Inoue a TKE replace the entire signal / tone (abstract; Fig. 3b; pages 4-5) which including rings of a ringback signal portions that would normally be routed to the source and reads on claims limitation "... replace the rings of a ringback signal that would normally be routed to the source".

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 572-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quynh H. Nguyen

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